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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,298	04/17/2007	Jaime Gosalvez Berenguer	U 016409-0	4147

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LADAS & PARRY LLP 26 WEST 61ST STREET NEW YORK, NY 10023		

EXAMINER	
CHUNDURU, SURYAPRABHA	

ART UNIT	PAPER NUMBER
1637	

NOTIFICATION DATE	DELIVERY MODE
10/29/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

nyuspatactions@ladas.com

Office Action Summary	Application No. 10/586,298	Applicant(s) GOSALVEZ BERENGUER ET AL.	
	Examiner Suryaprabha Chunduru	Art Unit 1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18 and 20-35 is/are pending in the application.
- 4a) Of the above claim(s) 31 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18, 20, 21, 24-29, 33 and 35 is/are rejected.
- 7) ☒ Claim(s) 22, 23, 30 and 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2006 and 29 March 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's response to the office action filed on August 16, 2010 has been considered and acknowledged.

Status of the Application

2. Currently claims 18, 20-30 and 33-35 are pending under examination. Claim 31-32 were previously withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group. All arguments and amendment have been fully considered and thoroughly reviewed and deemed persuasive in view of the amendment. The amendment introduces new limitation that was not present in the previously examined claims and necessitated the new rejections. The action is FINAL necessitated by the amendment.

New Grounds of Rejections necessitated by the Amendment

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18, 20-21, 24-29, 33, 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Richthoff et al. (Human Reproduction, Vol. 17, No. 12, pp. 3162-3169, 2002).

Richthoff et al. teach a method of claims 18, 29, to evaluate the integrity of chromatin DNA or DNA of sperm cells of an animal (human) comprising

(a) treating a sample containing the sperm (cell suspension), with a DNA denaturing solution (page 3164, col. 2, paragraph 2 under FCM SCSA);

(b) a single step treatment of the sample in solution obtained in step a) with a single lysis solution to extract nuclear proteins of the sperm cells (see page 3164, col. 2, paragraph 2 under FCM SCSA);

(c) evaluating the integrity of the chromatin/DNA of the sperm cells based on measurement of halo of the size of the sperm cells (see page 3164, col. 2, paragraph 2 under FCM SCSA).

With regard to claim 20-21, 33, Richthoff et al. teach that the lysis buffer comprises non-denaturing detergent, Triton X-100 (see page 3164, col. 2, paragraph 2 under FCM SCSA)

With regard to claim 24-26, Richthoff et al. teach that the denaturing solution contains hydrochloric acid (see page 3164, col. 2, paragraph 2 under FCM SCSA).

With regard to claim 27-28, Richthoff et al. teach that after the step a) and b) there is a staining step comprising wright type stain (acridine orange) (see page 3164, col. 2, paragraph 2 under FCM SCSA).

With regard to claim 35, Richoff et al. teach that the integrity of chromatin or DNA of sperm cells is evaluated through direct visual analysis by microscopy or applying digitalized images analysis software (see page 3164, col. 2, paragraph 2 under FCM SCSA). Accordingly the claims are anticipated.

Response to Arguments:

4. The rejection of claims 18-30, 33-35 under 35 USC 103(a) as being unpatentable over Fernandez et al. in view of Bezanehtak et al. is withdrawn herein in view of the amendment.

Allowable Subject Matter

5. Claims 22-23, 30 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 571-272-0783. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Suryaprabha Chunduru/

Primary Examiner, Art Unit 1637